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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Serial No.: 10/708,312  
Filed: February 24, 2004  
Art Unit: 1732  
Examiner: Lawrence Emile Lambelet  
Applicant: Todd L. DePue  
Title: TWO SHOT-CO-INJECTED AUTOMOTIVE INTERIOR TRIM  
ASSEMBLY AND METHOD  
Attorney Docket: MASLIAC-29  
Confirmation No.: 2311

Cincinnati, Ohio 45202

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Commissioner for Patents  
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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicant requests review of the rejections of claims in the above-identified application set forth in the final Office Action dated March 23, 2007. No amendments are being filed with this request, and it is being filed concurrently with a Notice of Appeal. The review is requested for the reasons set forth below.

### **REMARKS/ARGUMENTS FOR REVIEW**

Claims 1-5 and 7-9 remain pending in the application, and claims 5 and 7-9 stand rejected under 35 U.S.C. §103(a). Claims 1-4 were withdrawn from consideration as non-elected claims. For purposes of this request, Applicant focuses on independent claim 5. Applicant reserves comments on the dependent claims and/or additional arguments if the appeal proceeds.

Independent claim 5 is directed to a method of forming an automotive interior trim assembly in a two shot molding operation. The method includes:

forming a substrate member defining one of an automotive instrument panel, an interior door trim panel, an armrest, or a console by injecting a first material during the first shot of the molding operation;

co-injecting second and third materials onto the substrate member to form a cover member on the substrate member during the second shot of the molding operation, wherein the second material is an outer pliable layer and the third material is an inner compressible layer; and

covering the inner compressible layer with the outer pliable layer during the co-injecting step. (Emphasis added).

Applicant respectfully requests that the rejection of claim 5 be withdrawn because the applied references fail to teach or suggest injecting a first material during the first shot of the two-shot molding operation to form a substrate member, then co-injecting second and third materials onto the substrate member during the second shot of the molding operation to form a cover member on the substrate member. Rather, U.S. Patent No. 6,651,998 to Bertschi et al. is directed to an injection molding system wherein a first material 490 is injected into a mold to form an outer layer. (See Bertschi

'998 at col. 6, lines 47-62 and FIG. 16.) Second and third materials 444, 492 are then injected into the center of the first material 490. This is not the same as forming a substrate with the first material, then co-injecting second and third materials onto the substrate to form an outer pliable layer and an inner compressible layer, as set forth in claim 5.

The Examiner attempts to cure the deficiencies of Bertschi '998 with U.S. Patent No. 6,627,134 to Thomson and U.S. Patent No. 6,899,363 to Dry. However, both Thomson '134 and Dry '363 are directed to apparatus and methods for making articles using only two materials. None of the references, therefore, teaches or suggests co-injecting second and third materials to form a cover on a substrate, and the Examiner takes a mental leap that is not supported by the references in an effort to piece together the claimed invention.

Moreover, the Examiner alleges that the motivation to combine these references is "to use low cost recyclable material where it is not visible." (See final Office Action at page 3.) However, Bertschi '998 already discloses a molded article wherein a first material 490 covers the third material 492, and there is no need to modify Bertschi '998 in view of Thomson '134 or Dry '363. Accordingly, there is no motivation to combine the references as alleged by the Examiner, and Applicant asserts that a *prima facie* case of obviousness has not been made.

Yet, even if Bertschi '998 were combined with Thomson '134 and Dry '363, as asserted by the Examiner, there is no teaching or suggestion in the references to form a substrate member during the first shot of a molding operation, then to co-inject second

and third materials onto the substrate member to form a cover member during the second shot of the molding operation, as set forth in claim 5.

Claims 7-9 each depend from independent claim 5 and are in condition for allowance for at least the reasons discussed above for claim 5.

For at least the reasons discussed above, persons of ordinary skill in the art would not have been motivated to modify Bertschi '998 with Thomson '134 and Dry '363, as asserted by the Examiner. Yet, even if these references were combined, they would not result in the claimed invention. Accordingly, Applicant respectfully asserts that no *prima facie* case has been made, and the rejections should be withdrawn without forcing Applicant through the time and expense of a full-blown appeal.

Respectfully submitted,

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